

REMARKS

Claims 1-29 stand rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 1-29 of Application No. 10/109,260, now U.S. Patent No. 6,730,227, issued May 4, 2004. Applicants have herein submitted a timely filed terminal disclaimer, attached to this Response as Exhibit A, wherein the term of the patent issuing from the instant patent application is limited to the term of U.S. Patent No. 6,730,227.

Both this U.S. Patent Application and U.S. Patent No. 6,730,227 are commonly owned by Nalco Company {formally known as Ondeo Nalco Company, formally known as Nalco Chemical Company). Therefore, the requirement of “common ownership” of both the pending patent application and the previously issued patent is present in this matter.

With a timely filed terminal disclaimer herein submitted, in compliance with 37 C.F.R. 1.321(c), concurrently with this Response, Applicants request withdrawal of this rejection and that a Notice of Allowance be sent for all pending claims.

Claims 1, 2, 6-19 and 21-29 stand rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Hoots et al patent 5,435,969 in view of Hoots patent 5,171,450 and Zeiher et al patent 6,017,459. Applicants respectfully traverse this rejection on the grounds that neither Hoots ‘969 or Hoots ‘450 or Zeiher ‘459 teach or disclose or claim the instant claimed invention; that there is no suggestion in these three references, or in any other reference that Applicants are aware of, to combine the teachings of the three patents to teach or disclose the instant claimed invention and even if the three patents are improperly combined, they still do not teach or disclose the instant claimed invention.

The instant claimed invention is:

a method for monitoring a reverse osmosis membrane separation process including a reverse osmosis membrane capable of separating a feed stream into a first stream and a second stream to remove solutes from the feed stream comprising the steps of:
providing an inert fluorescent tracer and a tagged fluorescent agent;
introducing the inert fluorescent tracer and tagged fluorescent agent into the feed stream;
providing a fluorometer to detect the fluorescent signal of the inert fluorescent tracer and the tagged fluorescent agent in at least one of the feed stream, the first stream and the second stream; and
using the fluorometer to determine an amount of the inert fluorescent tracer and the tagged fluorescent agent in at least one of the feed stream, the first stream and the second stream.

In contrast to the instant claimed invention Hoots '969 teaches withdrawing a sample of water from an industrial water system and **adding a reagent to that water sample**, wherein the incipient reagent reacts with the non-fluorescing component of a water treating agent, to produce a moiety with a detectable fluorescent signal. The fluorescent signal of the moiety can be detected and measured and that measurement can be used to determine the amount of non-fluorescent component of the water-treating agent that is present. The instant claimed invention does not require or allow for the use of an incipient reagent to react with a non-fluorescent moiety to generate a moiety with a fluorescent signal. Accordingly, Hoots'969 cannot be used to render the instant claimed invention unpatentable.

In contrast to the instant claimed invention, Hoots '450 teaches a "Method of determining the concentration of a water soluble carbonyl polymeric treating agent added to a **circulating body of water confined in a water recirculating system...**".

The instant claimed invention is a method that is specific for reverse osmosis membrane separation processes, not to circulating bodies of water confined in water recirculating systems. Accordingly, Hoots'450 cannot be used to render the instant claimed invention unpatentable.

In contrast to the instant claimed invention, Zeiher '459 teaches "An apparatus for monitoring membrane deposition in a reverse osmosis system comprising:
an exterior body defining an interior compartment receiving a fluid stream; and

a support member positioned in the interior compartment removably supporting a reverse osmosis membrane coupon parallel to the direction of fluid flow of the fluid stream through the interior compartment allowing the collection of deposition present within the fluid stream on the reverse osmosis membrane coupon.”

The instant claimed invention is neither an apparatus for monitoring membrane deposition, nor is it a method for use of an apparatus for monitoring membrane deposition.

Applicants are unaware of any suggestion to combine the three cited references to teach, suggest or disclose the instant claimed invention. In fact, the three cited references are all classified into either different sections or into different subsections of a very broad (No. 210) section, (Hoots '969 in 422/14, Hoots '450 in 210/701, and Zeiher '459 in U.S. Class 210/650) which means a person of ordinary skill in the art would not reasonably be expected to evaluate their teachings together.

If the three references were improperly combined they still do not teach or disclose or suggest the instant claimed invention because the “membrane” reference concerns itself with monitoring depositions upon the membrane and the two “water treatment” references concern themselves with determining the concentration of water treatment agents in industrial fluid systems rather than determining flow in a reverse osmosis membrane system.

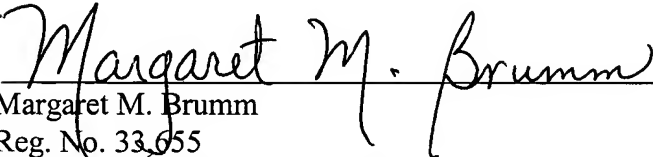
Accordingly, the combination of Hoots '969 and Hoots '450 and Zeiher '459 cannot teach or disclose or claim the instant claimed invention.

Based on the above remarks, Applicants respectfully request withdrawal of all pending rejections and that a Notice of Allowance be sent for all pending claims.

CONCLUSION

Applicants submit that based upon the above Remarks all pending claims are in condition for Allowance and courteously requests that a Notice of Allowance be sent for all pending claims.

Respectfully submitted,

A handwritten signature in cursive script that reads "Margaret M. Brumm". The signature is written over a horizontal line.

Margaret M. Brumm
Reg. No. 33,655
Patent & Licensing Department
Nalco Company
1601 W. Diehl Road
Naperville, Illinois 60563-1198
(630) 305-1423

Date: June 17, 2004